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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,660	06/03/2006	Paolo Dario	1014.1058	3944
41226	7590	11/12/2008	EXAMINER	
POLLACK, P.C. THE CHRYSLER BUILDING 132 EAST 43RD STREET, SUITE 760 NEW YORK, NY 10017			HORNINGER, JENNIFER LEA	
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
11/12/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,660	<b>Applicant(s)</b> DARIO ET AL.
	<b>Examiner</b> JENNIFER L. HORNBERGER	<b>Art Unit</b> 3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 07 August 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s)       is/are withdrawn from consideration.

5) Claim(s)       is/are allowed.

6) Claim(s) 1-12 is/are rejected.

7) Claim(s)       is/are objected to.

8) Claim(s)       are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on       is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No.      .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)

Paper No(s)/Mail Date      

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date      

5) Notice of Informal Patent Application

6) Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2 and 11 are rejected under 35 U.S.C. 112, second paragraph, as indefinite by using relative terminology referencing an object that is variable (the specific weight of internal organs, blood, or other fluid). *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989). *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). See MPEP 2173.05(b).

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoon (US 6,248,088).

Regarding claim 10, Yoon discloses an organic fluid absorbing plug (16) for surgical use, the plug comprising an elongated body constructed of a material having haemostatic properties, the body connected to a radio-opaque locator (22) capable of floating relative to internal organs, blood, or other fluids present at the surgical site, the body and the locator being generally simultaneously delivered and recovered from the surgical site.

Regarding claim 11, Yoon discloses the locator (22) comprises at least one ball is connected to the plug by a wire (Fig. 7).

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon (US 6,248,088) in view of Reynolds et al (US 6,673,080).

Regarding claim 1, Yoon discloses a surgical device for removing organic fluids from a body cavity, the device comprising an absorbing plug (16), a tubular body (28) suitable for slidably housing the plug, and a plunger (30) slidably engageable in the tubular body so as to push the plug outside thereof and place it at the surgical site (col. 4, ln. 49-60), the tubular body and plunger having a distal end and a proximal end, wherein the plug is connected to a radio-opaque locator (22) capable of floating relative to internal organs, blood, or other fluids present at the surgical site. Yoon discloses the removal of the plug but fails to disclose the method and means of removal (col. 3, ln. 52-54). Yoon fails to disclose that at the distal end of the plunger, a handle is provided for gripping the locator for recovering the plug after use by retracting the plunger inside the tubular body. Reynolds et al. disclose providing a handle (30) for gripping and recovering material by retracting a plunger inside a tubular body (Fig. 1; col. 2, ln. 30-35). Therefore, it would have been obvious to one of ordinary skill in the art to have provided the handle as taught by Reynolds et al. in the device of Yoon in order to provide a means for removing the plug from the body.

Regarding claim 2, Yoon discloses the locator (22) comprises at least one ball connected to the plug by a wire (Fig. 7).

Regarding claim 3, Yoon does not disclose the size of the locator relative to the tube. Yoon discloses successively inserting the plug through a tubular body (col. 4, ln. 28-30). It

would have been obvious to one of ordinary skill in the art to have made the locator smaller than the inner dimensions of the tubular body so the locator may pass through the tubular body to allow for easier sequential insertion of the plugs.

Regarding claims 4 and 5, Yoon fails to disclose a loop at the distal end of the plunger. However, Reynolds et al. disclose that it is well-known to retrieve material from within the body using a loop at the end of a plunger to grasp and retract the material so that it may be extracted from the body. Reynolds et al. disclose the loop is formed by a relatively thin plate bent and connected at its ends to the distal end of the stem of the plunger (Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art to have provided a loop for grasping the locator as suggested by Reynolds because it is a well-known structure used in the retrieval of foreign objects from the body. It also would have been obvious to one of ordinary skill in the art to make the loop generally wider than the locator so that the loop would fit around the ball because otherwise the loop could not function to retrieve the plug.

Regarding claim 6, Reynolds et al. disclose at the proximal end of the tubular body and of the stem, a handle is provided for actuating axial sliding of the stem in one direction or the other as a result of corresponding pressure actions exerted simultaneously in opposite directions on the handle (Fig. 1; col. 6, ln. 21-35).

Regarding claim 7, Reynolds et al. disclose the handle is of a ring type so as to allow engagement with the fingers of a user (Fig. 1).

Regarding claim 8, Reynolds et al. disclose a pair of handle rings are provided at the proximal end of the tubular body, the rings being generally diametrically opposite to and coplanar with one another, whereas at the proximal end of the stem, a handle ring is provided, generally coplanar thereto. (Fig. 1)

Regarding claim 9, Yoon discloses that the plug is preferably white in color to provide contrast with the surrounding tissue (col. 5, ln. 5-7). Yoon however fails to disclose the color of the locator surface. It would have been obvious to one of ordinary skill in the art to have also made the locator white or a relatively light color to provide contrast with the surrounding tissue and fluids as suggested by Yoon.

3. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon.

Regarding claim 12, Yoon discloses that the plug is preferably white in color to provide contrast with the surrounding tissue (col. 5, ln. 5-7). Yoon however fails to disclose the color of the locator or "ball" surface. It would have been obvious to one of ordinary skill in the art to have also made the locator white or other relatively light color to provide contrast with the surrounding tissue and fluids as suggested by Yoon.

***Response to Arguments***

4. Applicant's arguments filed 08/07/2008 have been fully considered but they are not persuasive. In response to applicant's arguments regarding rejection of claims 2 and 11 under 35 U.S.C. 112, 2nd paragraph, the examiner maintains the rejection because of the large range of densities of internal organs, blood, and particularly "other fluids" which would each vary not only within one patient but also widely from the size of the patient.

5. In response to applicant's argument that tag 22 of Yoon must be larger than the cross section of the tube, there is nothing disclosed in the specification with respect to the size of the tag to indicate that the tag must absolutely be too large fit through the tube. Further, the tag is disclosed as being radiopaque which would be unnecessary if the tag was always externally located. Therefore, Yoon has not disclosed a reason to discourage one from modifying the locator to fit through the tube.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER L. HORNBERGER whose telephone number is (571)270-3642. The examiner can normally be reached on Monday through Friday from 8am-5pm, Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlh  
10/29/08

/Todd E. Manahan/  
Supervisory Patent Examiner, Art Unit 3731